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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,329	05/09/2002	Volker Deichmann	112740-372	6261
29177	7590	10/20/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC			TRAN, TUAN A	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	

2682

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,329	Applicant(s) DEICHMANN ET AL.	
	Examiner Tuan A. Tran	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom et al (WO 98/30053) in view of Iwata et al. (6,009,338).

Regarding claims 9 and 15, Holmstrom discloses a mobile phone (See fig. 1), comprising: a nonvolatile memory; an SIM card; at least one electronic telephone directory, one of the at least one of the electronic telephone directory being stored in a memory of the SIM card and another of the at least one of the electronic telephone directory, if applicable, being stored in the nonvolatile memory, a number of attributes including telephone numbers and names of the at least one telephone directory being prescribed by the SIM card (See fig.1, Table 1 and page 3 lines 5-8). However, Holmstrom does not mention that at least one database stored in the nonvolatile memory, each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory may be assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry and wherein the at least one database is an expansion telephone directory. Iwata

teaches a mobile phone (See fig. 1) comprising an electronic telephone directory wherein each entry of a telephone directory may be assigned to a corresponding expansion telephone directory entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry (See figs. 6-7 and col. 14 line 4 to col. 15 line 13). Since both Holmstrom & Iwata teach about the mobile phone having telephone directory, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Iwata in creating expansion telephone directories for the electronic telephone directory of the mobile phone as disclosed by Holmstrom for the advantage of allowing users to store additional information associated with the telephone directory.

Regarding claim 10, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each telephone directory is assigned precisely one database (See figs. 6-7).

Regarding claim 11, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each database has a key (in this case, the underlined name) associated with the respective assignment between the database and the associated telephone directory (See figs. 6-7 and col. 14 line 4 to col. 15 line 13).

Regarding claims 12-14, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each of the database entries includes a characteristic diagram which points to the corresponding telephone directory entry in the corresponding telephone directory, wherein the characteristic diagram of the database entry contains the corresponding telephone number and the data field of the database entry contains the

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additional attributes of the telephone number of the corresponding telephone directory (See fig. 7 and col. 14 line 64 to col. 15 line 13).

Regarding claim 16, Holmstrom & Iwata disclose as cited in claim 15. Iwata further discloses the expansion telephone directory stored in the nonvolatile memory differs in format (in term of the amount of data being stored) from the electronic telephone directory stored in the SIM card (See fig. 7). However, they do not mention that the expansion telephone directory being assigned by an IMSI to the electronic telephone directory. IMSI is known as an identification (or the name) of the SIM card, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to assign the expansion telephone directory to the telephone directory entry represented by the IMSI for the advantage of allowing user to store additional information associate with the SIM card.

Response to Arguments

Applicant's arguments filed 07/05/2005 have been fully considered but they are not persuasive.

a. In response to applicant's argument (See Remark, page 5-6) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Holmstrom discloses a mobile phone comprising at least one electronic telephone directory wherein one of the at least one of the electronic telephone directory being stored in a memory of a SIM card and another of the at least one electronic telephone directory being stored in a nonvolatile memory of the mobile phone (See page 3, Table 1 and lines 5-9). However, Holmstrom does not mention that at least one database stored in the nonvolatile memory being assigned to one of the at least one electronic telephone directory as an expansion telephone directory. Iwata teaches a mobile phone (See fig. 1) comprising an electronic telephone directory wherein each entry of a telephone directory may be assigned to a corresponding expansion telephone directory (See figs. 6-7 and col. 14 line 4 to col. 15 line 13). Since both Holmstrom & Iwata teach about the mobile phone having telephone directory; therefore, it would have been obvious to one skilled in the art to create expansion telephone directory, as taught by Iwata, for the telephone directory of the mobile phone as disclosed by Holmstrom in order to allow users to store additional information associated with the telephone directory. The combination of Holmstrom & Iwata reads perfectly on the claimed subject matters of independent claim 9 and therefore the rejections are proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan Tran** whose telephone number is **(571) 272-7858**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Quochien Vuong**, can be reached at **(571) 272-7902**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

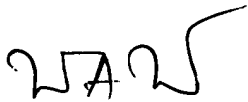
or faxed to:

(571) 273-8300 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Tuan Tran

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 10/17/05

QUOCHIEN B. VUONG
PRIMARY EXAMINER